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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/039,342      | 11/19/2001  | Richard L. Borders   | 8266-0738           | 1486             |

7590 10/02/2003

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EXAMINER

TONG, NINA C

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2632

DATE MAILED: 10/02/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/039,342

Applicant(s)

BORDERS ET AL.

Examiner

Nina Tong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Oath/Declaration*

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

The 119 (e) benefit for the provisional application 60/064,709 filed 11/07/1997 is not being claimed in the declaration.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-6,23-34 are rejected under 35 U.S.C. 102(e) as being anticipated by White et al. (6,353,413).

Regarding claims 1,2,3, White et al. discloses a multi-function universal controller system, wherein the system shows an integrated personal communication and data entry device

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(UC 10 – pager/cellular phone & PDA/PC – col.3 lines 22-35) which comprises the portable housing (rectangular box) enclosing the controller (computer 70) coupled to the paging device (pager – col.3 lines 22-35) and the voice recording device (microphone 31 – col.3 lines 54-55).

Regarding claim 4, the claimed cellular telephone transceiver (col.3 line 28-29).

Regarding claim 5, the claimed radio transceiver for two-way communication (RF transceiver 72).

Regarding claim 6, the claimed infrared transmitter (IR transmitter 36).

Regarding claim 23, White et al. discloses a multi-function universal controller system, wherein the system shows an integrated personal communication and data entry device (UC 10 – pager/cellular phone & PDA/PC – col.3 lines 22-35) which comprises the portable housing (rectangular box) enclosing the controller (computer 70) coupled to the paging device (pager – col.3 lines 22-35) and the cellular telephone transceiver (cellular phone – col.3 lines 22-35).

Regarding claim 24, the claimed radio transceiver for two-way communication (RF transceiver 72).

Regarding claim 25, the claimed infrared transmitter (IR transmitter 36).

Regarding claim 26, the claimed voice recording device (microphone 31 – col.3 lines 54-55).

Regarding claim 27, White et al. discloses a multi-function universal controller system, wherein the system shows an integrated personal communication and data entry device (UC 10 – pager/cellular phone & PDA/PC – col.3 lines 22-35) which comprises the portable housing (rectangular box) enclosing the controller (computer 70) coupled to the paging device (pager – col.3 lines 22-35) and the radio transceiver for two-way communication (RF transceiver 72).

Regarding claim 28, the claimed cellular telephone transceiver (cellular phone col.3 lines 22-35).

Regarding claim 29, the claimed infrared transmitter (IR transmitter 36).

Regarding claim 30, the claimed voice recording device (microphone 31 – col.3 lines 54-55).

Regarding claim 31, White et al. discloses a multi-function universal controller system, wherein the system shows an integrated personal communication and data entry device (UC 10 – pager/cellular phone & PDA/PC – col.3 lines 22-35) which comprises the portable housing (rectangular box) enclosing the controller (computer 70) coupled to the paging device (pager – col.3 lines 22-35) and the infrared transmitter (IF transmitter 36).

Regarding claim 32, the claimed cellular telephone transceiver (cellular phone col.3 lines 22-35).

Regarding claim 33, the claimed radio transceiver for two-way communication (RF transceiver 72).

Regarding claim 34, the claimed voice recording device (microphone 31 – col.3 lines 54-55).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (6,353,413) in view of Walters et al. (6,453,281).

Regarding claim 7, White et al. fails to specify the claimed “voice recording device is configured to digitize voice data and to transform the digitized voice data into computer readable text data”. However, it is well-known in the art of providing the speech/text converter as desired.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the well-known speech/text converter in White et al. for converting the voice into text as taught by Walters et al. for convenience and for performing the same function as desired.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (6,353,413) in view of Kita et al. (4,717,261).

Regarding claim 8, White et al. discloses a computer which inherently included a clock. White et al. fails to specify the claimed “record time and date corresponding to the recorded voice data”. It is well-known in the art of recording time and date corresponding to the recorded voice data for ensuring the timing of the recorded voice messages for convenience as taught by Kita et al.. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the clock in the computer for recording the time and date corresponding the recorded voice data in White et al. as taught by Kita et al. for performing the same function as desired and for convenience and for ensuring the timing of the recorded voice messages.

7. Claims 9-11,18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (6,353,413).

Regarding claims 9,10, White et al. fails to specify the claimed “record voice data only after inputting ID” & “record voice data only after inputting voice print information”. However, it is well-known in the art for the security purpose for inputting any kind of identification, such

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as ID, voice print information, before authorizing to use a device/system. Also, as long as the system is function the same, providing with or without the security function would not constitute an inventive step but an obvious design choice. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the well-known security system, such as by inputting an ID or voice print information, before authorizing to use the device of White et al. for performing the same function as desired and for security purpose.

Regarding claim 11, White et al. fails to specify the claimed “transmit voice information over a wireless communication link to a hospital data system”. However, White et al. does show the function of wirelessly transmitting sound data to a remote location. As long as the system is function the same, transmitting the voice data to any remote location would not constitute an inventive step but an obvious design choice. It would have been obvious to one of ordinary skill in the art at the time the invention was made to transmit the voice data wirelessly to any remote location, such as the hospital data system, in White et al. for performing the same function as desired.

Regarding claims 18,19,20,21, White et al. fails to specify the claimed housing/pager is coupled to the caregiver’s wrist, or the claimed pager is coupled to the caregiver’s waist/neck. However, as long as the system/device is function the same, couple the device to any person’s wrist, waist or neck by any well-known attachment means would not constitute an inventive step but an obvious design choice. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the device of White et al. with any well-known



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attachment means such that the device is coupled to any person's, such as the caregiver's, wrist, waist, or neck for convenience and for performing the same function as desired.

Regarding claim 22, White et al. fails to specify the claimed "flexible sterile sheath configured to surround the housing". However, as long as the system/device is function the same, employing various kind of housing material would not constitute an inventive step but an obvious design choice. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ any well-known housing material, such as the flexible sterile sheath configured to surround the housing, for the device of White et al. for performing the same function as desired and for providing a more safety and comfortable housing to be carried by the user.

8. Claims 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimura (5,226,090) in view of Brant et al. (5,970,457).

Regarding claims 35-37, Kimura discloses a voice command to remotely control a device (103) via a transmitter (101,17,D1 remote control signal), wherein the claimed voice recording function is met by the speech recognition circuit 15, controller 16, talk switch 12, mode selector switch 13 and microphone M.

Kimura fails to specify the claimed medical equipment.

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However, Brant teaches the concept of employing voice command to control the medical equipment. Also, as long as the system of the voice command to remotely control a device, controlling any device would not constitute an inventive step but an obvious design choice. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the claimed system of Kimura to control any device, such as the medical equipment, as taught by Brant, for performing the same function as desired.

The above combination fails to specify the housing of the voice recorder coupled to the caregiver's head. However, Brant teaches the concept employ the headphone since hands free is required for the doctor to perform the surgery. Since it would have been obvious to control the medical equipment, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a hands free method, such as couple the housing of the device of Kimura to the caregiver's head, in the above combination for performing the same function as desired and for convenience.

#### ***Allowable Subject Matter***

9. Claims 12,13,14,15,16,17, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Bornn et al. Disclosed a cardiorespiratory alert system, which comprises the nurse unit with transceiver, microphone and speaker (no pager and voice recorder).

Ballantyne et al. Disclosed a health care system which comprises the PCS and PDA.

Dempsey et al. Disclosed a handheld clinical terminal (Date no good).

Kikinis et al. Disclosed the PDA could couple to the cellular phone and pager.

Akahane disclosed a portable voice recorder and messages transmitter.

Feinberg disclosed the medical information system, wherein the patient's record could be retrieved from the remote computer database after inputting the patient ID and user ID.

Leyendecker disclosed the two way communication device which send or receive the recorded voice messages.

Russek disclosed the pager on the wrist in the hospital.

Lepkofker disclosed the individual location mounted on the child's wrist with microphone and pager.

Moshfeghi et al. Disclosed the voice converted to text (date no good).

Webb disclosed a two-way pager worn by the patient; only one way.

Wicks et al. Disclosed a medication alert pager on the neck/waist.

Thorne disclosed a computer pager device on the belt/waist.

Rebstock et al. Disclosed a wireless healthcare communication system.

White et al. (6,408,272) disclosed the local device with paging and voice recording (date no good).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nina Tong whose telephone number is 703-305-4831. The examiner can normally be reached on Mon-Wed. (9:30 -8:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Wu can be reached on 703-308-6730. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

Nina Tong  
Primary Examiner  
Art Unit 2632

Nina Tong  
September 17, 2003

